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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,896	04/27/2001	Masaharu Hayashi	0425-0836P	7584
2292	7590	04/19/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER

1616

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/842,896	<b>Applicant(s)</b> HAYASHI ET AL.	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 07 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 4,6-8,10,12 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 4,6-8,10,12,14-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- I. Applicant's arguments, see paper, filed 2/7/06, with respect to the rejection(s) of claim(s) 4,6-8,10,12,14-19 under 35 USC 103(a) as being obvious over Kim et al (USPN 5674897; 10/7/97) in view of Szoka et al (USPN 4394149; 7/19/83) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.
- II. Rejection of claims under 35 USC 103(a) as being obvious over Kim et al (USPN 5674897; 10/7/97) in view of Szoka et al (USPN 4394149; 7/19/83) will not be maintained in light of amendment filed 2/7/06. Applicant is correct in that Kim and Szoka are not analogous art. Kim is to the control of nematodes in plants, whereas Szoka is to plant nutrients.
- III. New 103(a) rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,6-8,10,12,14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al (USPN 5674897; 10/7/97) in view of Basinger et al (USAN 2001/0019728; 09/06/01). Kim teaches a composition comprising 10 – 20,000 ppm C8 to C14 fatty acid esters plus a surfactant plus water. Kim teaches a method of applying the composition to plants to control nematodes. Kim does not state that invention activates or promotes plant growth. See abstract, column 4 lines 1-63, column 8 lines

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58-65, and claims 1-4. However, it is obvious that if the composition is applied to the plant that it would activate plant growth since it is used to control nematodes from destroying plants. Kim does not teach the invention comprising fertilizer or EDTA or nutrients or mixtures thereof. However, Basinger teaches a method for protecting an agricultural substance (plant) comprising treating the plant with a composition comprising iodine, fertilizer and chelater (EDTA). See abstract, paragraph 27, claims 45,49, and 50. Basinger teaches that the composition is used to control pests such as nematodes. See abstract, paragraph 18. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Kim to include the nutrients, fertilizer, and EDTA taught by Basinger. One would have been motivated to do this in order to enhance the effectiveness of Kim's invention at controlling nematode infestation as well as promoting the growth of plants. One would have also been motivated to do this since both inventions are to plant treatment compositions for controlling nematodes. With respect to the amounts of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts of ingredients. One would have been motivated to do this in order to develop the most effective composition for controlling nematodes in plants. The skilled artisan after reviewing the references would have been motivated to do the claimed method since both individual inventions are to the control of nematodes, i.e., it is obvious to combine inventions having the same utility. Mr. Suzuki's declaration argues that promoting plant growth and controlling nematodes are separate concepts. Applicant argues that at page 1 line 13 to page 2 line 1 of the specification shows the inventive plant activating agent functions in plant

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growth (e.g. improved reproductive ability) on a cellular level. Examiner argues that once a nematocide is applied to the plant it protects plants from being destroyed by nematodes, which in turn promotes the growth of the plant. Also note that Basinger employs a composition not only comprising a pesticide as protectant against nematocides, but also contains nutrients and fertilizers to promote the growth of plants. Therefore it is within the scope of the pesticide art to make an invention that promotes plant growth while at the same time control nematode infestation. For this reason, an artisan would have reasonable expectation of success. Applicant argues that page 1 line 13 to page 2 line 1 of the specification shows that the inventive plant activating agent functions in plant growth on a cellular level.

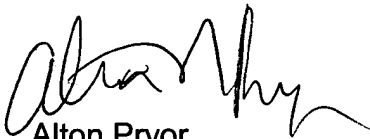
***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', is positioned above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616